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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/635,929

08/07/2003

Yasuhide Horiuchi

041-1930ARI

1062

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7590

08/20/2008

CLARK & BRODY

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WASHINGTON, DC 20005

EXAMINER

CHRISTENSEN, SCOTT B

ART UNIT

PAPER NUMBER

2144

MAIL DATE

DELIVERY MODE

08/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/635,929	<b>Applicant(s)</b> HORIUCHI ET AL.	
	<b>Examiner</b> Scott Christensen	<b>Art Unit</b> 2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 4-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/1/2007, 9/5/2006, 3/15/2005</u> .                           | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Office Action is in regards to the most recent papers filed on 3/02/2004.

### ***Restrictions***

2. Newly submitted claims 4-15 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 4-6 are directed to a terminal to be connected to an apparatus that is arranged to transmit to the apparatus information related to the capability of the terminal itself.

Claims 7-15 are directed towards an information processing apparatus with a receiving section and a terminal responsive section, where the receiving section and the responsiveness section receive and respond to the information transmitted from a terminal, where the responsive section obtains information indicative of capabilities of the terminal.

Meanwhile, claims 1-3 are directed towards a transmitter/receiver that allows for management of multiple spools as a single spool with capabilities to assign identifiers to individual mails and ensure that the same mails have the same mail ID.

Claim 1 appears to be directed towards an apparatus that the terminal of claim 4 may the information to, while the terminal of claim 4 may be a terminal such as the terminal connected to the transmitter/receiver of claim 1. However, the functionality of the terminal to transmit its own capabilities is not claimed in any of claims 1-3. The capabilities of the terminal appears to be based on information from a position control

unit, which is claimed as being part of the transmitter/receiver, and not part of the terminal (See claim 3, which depends from claim 1). There is no disclosure within any of claims 1-3 of how this information is received by the position information control unit, or that it is performed in the manner of claim 4.

Meanwhile, claim 4 is merely directed towards the terminal and how it sends its own capabilities to an apparatus, and provides for none of the functionality of claims 1-3.

Claim 7, meanwhile, provides for an apparatus that receives and responds to information such as that sent by the terminal of claim 4, but includes none of the functionality of the transmitter/receiver of claims 1-3.

As such, claims 1-3 are drawn towards a distinct invention from that of claims 4-6 and 7-15, and claims 4-6 and 7-15 are drawn towards a distinct invention from that of claims 1-3.

Since applicant has received a patent for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 4-15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.176.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, the instant claim includes "means for converting a reading command for reading out a mail from a single spool..." It is unclear if "a single spool" refers to one of the spools from the plurality of spools or the single spool from column 7, lines 9-10 ("...by regarding said plurality of mail spools as a single spool"). For purposes of prosecution, it is assumed that "a single spool," as in the cited passage refers to one of the spools from the plurality of spools.

Further, with regard to claim 1, the claim includes many recitation of "a mail." It is unclear if each of the mails refer to the same mail or different mails. Applicant should amend the instant claim to clearly distinguish between the recitations of "a mail" that are intended to be distinct, and clearly demonstrate which recitations of "a mail" are intended to refer to the same mail. Claim 2 includes additional recitations of "a mail" that should also be addressed.

Further, with regard to claim 1, the instant claim includes the phrase, "which have been determined by said means for determining." Claim 1, however, recites two means for determining in the entirety of the claim. The recitation for "means for determining" should be amended to clearly recite which means for determining it is referring to.

With regard to claim 2, the instant claim includes the phrase, "means for converting the reading command to a reading command for..." It is unclear if this is intended to refer to the reading command for reading out a mail from a single spool or to

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the reading command for reading out a mail from each of said spools. Applicant should amend the instant claims to clearly distinguish between each of the reading commands, and clearly demonstrate which recitations of "a reading command" are intended to refer to the same reading command.

Further, with regard to claim 2, the instant claim includes the phrase "...which have been determined by said means for determining in case two or more spools..." It is unclear which means for determining this refers to, as claim 1 includes means for determining...any mail spools where a mail designated to be read out is stored and means for determining whether or not plural mails retained in said plurality of mail spools have a same mail ID given by a transmitter. For purposes of prosecution, it is assumed that the means for determining, as in claim 2, refers to means for determining...any mail spools where a mail designated to be read out is stored, as in claim 1.

#### ***Allowable Subject Matter***

5. Claims 1-3 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

William Vaughn allowed the instant claims resulting in the issuance of US Patent 6,272,530. As previously indicated in application number 08/873561, from which US Patent 6,272,530 issued, none of the prior art of record discloses or suggests the transmitter-receiver of claim 1. As no clear errors have been found with respect to

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allowable subject matter, full faith and credit is being given to the action of William Vaughn.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Christensen whose telephone number is (571)270-1144. The examiner can normally be reached on Monday through Thursday 6:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul H Kang/  
Primary Examiner, Art Unit 2144

/S. C./  
Examiner, Art Unit 2144